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AUG 16 2007

HP Docket No. 10016783-1

REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 2-3, 6, 15, 21, 30, and 33 have been amended, claims 4 and 17-18 have been cancelled without prejudice, and new claims 34-42 have been added. Support for any claim amendments and new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections**Rejection Under 35USC §102**

Claims 2-3, 6, 15, 21-24, and 30 have been rejected under 35 USC §102(e), as being anticipated by U.S. patent application publication 2002/0032652 to Aoki et al. ("Aoki"). Applicants respectfully traverse the rejection and request reconsideration based on features in the claims which are neither disclosed nor suggested in the cited reference.

As to a rejection under §102, "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, (1984, CAFC) 221 U.S.P.Q. 385. The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp.*, 514 F.2d 901,

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185 U.S.P.Q. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The rejection of independent claim 3 is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 3 recites:

“3. (Currently amended) A print by reference method executable by a portable wireless device, the method comprising the steps of:
obtaining a reference to print content stored at a location indicated by the reference; and
wirelessly communicating the reference to another device to initiate a print by reference of the print content,
wherein the print content is printed in response to receipt of the reference by the another device, and wherein the reference specifies print format information.” (emphasis added)

Applicants respectfully believe that this rejection is inadequate to establish a prima facie case of anticipation because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims.

The Office states that the base station 200 of the Aoki reference corresponds to the “another device” recited in claim 3 and numerous other claims (Office Action, p.8). The wireless device 100 of the Aoki reference, which corresponds to the “portable wireless device” recited in claim 3 and numerous other claims,

“communicates with the portable terminal 100 by wireless [and] is connected to the junction station 210. When the portable terminal 100 is connected to the Internet 400, the junction station 210 serves on behalf of the portable terminal 100 as a terminal on the Internet 400, wherein data which is received from the portable terminal 100 via a base station 200 is transmitted to a designated terminal via the Internet 400, and wherein data on the designated terminal connected to the Internet 400 is transmitted to the portable terminal 100 via the base station 200.” (para. [0061])

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Claim 3 recites that a reference to print content stored at a location indicated by the reference is wirelessly communicated to another device in order to initiate a print by reference of the print content, and that the print content is printed in response to receipt of the reference by the another device. However, the system of the Aoki reference does not operate in this manner.

As disclosed by the Aoki reference, and with reference to Fig. 4 thereof, the portable terminal 100 first wirelessly transmits a data print request to base station 200 (Fig. 4; step S108). “[T]he data to be included in the data print request is generated with ... the URL of the WWW server DS as printing target storage location data indicating the URL” (para. [0079]). The “reference” corresponds to the URL. Thus wirelessly transmitting the data print request corresponds to “wirelessly communicating the reference to another device”, as recited in claim 3.

However, the Aoki reference fails to teach the limitation that “the print content is printed in response to receipt of the reference by the another device”, as required by claim 3. Instead, no printing occurs in response to the receipt of the URL of the WWW server DS by base station 200. Instead, the portable terminal 100 must wirelessly transmit a second, different data print execution request (step S124) to the base station 200 in order for printing to occur (para. [0085]-[0086]). It is further noted that there is no disclosure in the Aoki reference that the data print execution request includes the reference. Indeed, there would be no need for the data print execution request to include the reference because the reference has already been communicated to base station 200 as part of the prior transmission of the data print request.

Furthermore, even though the data print request has been wirelessly transmitted, printing may never occur. For example, instead of the subsequent data print execution request, a subsequent halt signal (step S132) may be wirelessly transmitted from the terminal 100 to the base station 200 in order to halt the data print (para. [0086]).

Thus, as disclosed by the Aoki reference, the print content is not printed in response to receipt of the reference by the another device. The novel features of the present invention are not anticipated by the Aoki reference in that the essential element of wirelessly communicating the reference to another device to initiate a print by reference of the print content wherein the print

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content is printed in response to receipt of the reference by the another device, arranged as required by the claim and recited in as complete detail as in the claim, is absent from the reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claims 21 and 30 each recite limitations similar to those of claim 3, discussed above. For similar reasons as explained heretofore with regard to claim 3, the novel features of the present invention are not anticipated by the Aoki reference in that at least one essential element, arranged as required by the claims and in as complete detail as in the claims, is absent from the reference. Therefore, the rejection of these independent claims, and their corresponding dependent claims 22-24 is improper at least for this reason and should be withdrawn.

The rejection of independent claim 2 is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 2 recites:

"2. (Currently amended) A print by reference method executable by a portable wireless device, the method comprising the steps of:
obtaining a reference to print content stored at a location indicated by the reference; and
wirelessly communicating the reference to another device to initiate a print by reference of the print content,
wherein the print content is printed in response to receipt of the reference by the another device, and wherein the reference specifies billing information." (emphasis added)

Applicants respectfully believe that this rejection is inadequate to establish a prima facie case of anticipation because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims.

First, with regard to the limitation of wirelessly communicating the reference to another device to initiate a print by reference of the print content, wherein the print content is printed in response to receipt of the reference by the another device, the Aoki reference does not disclose

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this limitation for similar reasons as explained heretofore with regard to claim 3.

Second, with regard to the limitation of the reference specifying billing information, the Office states that these features are disclosed by paragraphs [0111]-[0112] of the Aoki reference. Applicants respectfully disagree, in that the reference of the Aoki reference does not specify billing information. Fig. 6 illustrates the process of the data output control terminal 300:

"In step S200, it is determined whether or not the data print request has been received from the portable terminal 100. If it is determined that the data print request has been received (Yes), the processes move to step S202, in which data included in the received data print request (including at least the portable-terminal-position data and the print target storage location data) is obtained. ... In step S218, it is determined whether or not a data print execution request has been received from the portable terminal 100. If it is determined that the data print request has been received (Yes), the processes move to step S220, in which authentication data is received from the portable terminal 100. The processes then move to step S222, in which authentication processes are executed, based on the received authentication data, in order to determine whether or not the user of the portable terminal 100 is a legitimate user of the print service provided by the data output control terminal 300. ... Next, in step S224, ... if the user is determined as a legitimate user (Yes), the processes move to step S226, in which the data which can be printed by the determined printing apparatus PR is transmitted to the printing apparatus PR. The processes then move to step S228, in which billing processes are executed in which billing is executed in accordance with the result of usage by the portable terminal 100 of the print service provided by the data output control terminal 300. Next, the processes move to step S230, in which a billing message, which indicates the service charge calculated in the billing processes of step S228 is transmitted to the portable terminal 100." (para. [0098]-[0106]; emphasis added)

Thus it can be seen that the reference to print content stored at a location indicated by the reference (i.e. the data print request received at step S200) does not specify billing information. The Aoki reference extensively specifies (para. [0078]) the information that can be included with the data print request: a URL, a desired service area, print specifications (c.g. paper size, color/monochrome, printing resolution, printing speed), print data format, etc. However billing information is absent from this extensive list. Rather, billing information, which is associated with the user of portable terminal 100, is determined from the authentication data that is received at step S220, separate from and subsequent to the data print request received at step S200.

The novel features of the present invention are not anticipated by the Aoki reference in

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that the essential element, arranged as required by the claim and recited in as complete detail as in the claim, is absent from the reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

The rejection of independent claim 6 is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 6 recites:

“6. (Currently amended) A print by reference method executable by a portable wireless device, the method comprising the steps of:
obtaining a reference to print content stored at a location indicated by the reference; and
wirelessly communicating the reference to another device to initiate a print by reference of the print content,
wherein the print content is printed in response to receipt of the reference by the another device, and wherein the reference specifies a number of copies of the print content to be printed by a print device.” (emphasis added)

Applicants respectfully believe that this rejection is inadequate to establish a prima facie case of anticipation because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims.

First, with regard to the limitation of wirelessly communicating the reference to another device to initiate a print by reference of the print content, wherein the print content is printed in response to receipt of the reference by the another device, the Aoki reference does not disclose this limitation for similar reasons as explained heretofore with regard to claim 3.

Second, with regard to the limitation of the reference specifying a number of copies of the print content to be printed by a print device, the Office states that this feature is disclosed by paragraph [0143] of the Aoki reference. Applicants respectfully disagree, in that the reference to print content of the Aoki reference does not specify the number of copies of the print content to be printed by a print device:

“The processes then move to step S104, in which various information associated with

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printing is input via the key panel 40. As the various information associated with printing, the user inputs, for example, a URL which uniquely identifies the location of the WWW server DS on the Internet, which stores the print data to be printed, a desired service area which is the approximate location where the service of output data is desired, print specifications of the printing apparatus PR, such as the size of paper, a designation of color/monochrome, printing resolution, and printing speed, a data format of the print data to be printed, and when a printing apparatus PR is to be directly specified, a printing apparatus ID for identifying the printing apparatus PR. All of these input items are not necessarily required, but are selectively input according to user requirements." (para. [0078])

Nowhere among the above items is found the specification of a number of copies of the print content to be printed.

Furthermore, paragraph [0143] cited by the Office is not directed to the contents of the reference to print content. Rather, it describes a calculation by data output control terminal 300 that can define a service charge for the user of portable terminal 100 without the printing apparatus counting the number of prints.

The novel features of the present invention are not anticipated by the Aoki reference in that at least one essential element, arranged as required by the claim and recited in as complete detail as in the claim, is absent from the reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

The rejection of independent claim 15 is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 15 recites:

"15. (Previously presented) A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at a location indicated by the reference;
wirelessly communicating the reference to another device to initiate a print by reference of the print content, wherein the print content is printed in response to receipt of the reference by the another device; and

communicating a discovery signal that comprises a request for information about a capability of the another device." (emphasis added)

Applicants respectfully believe that this rejection is inadequate to establish a prima facie

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case of anticipation because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims.

First, with regard to the limitation of wirelessly communicating the reference to another device to initiate a print by reference of the print content, wherein the print content is printed in response to receipt of the reference by the another device the Aoki reference does not disclose this limitation for similar reasons as explained heretofore with regard to claim 3.

Second, with regard to the limitation of communicating a discovery signal that comprises a request for information about a capability of another device, the Office states that "Aoki teaches communications procedures that are part of a standard protocol between the wireless device 100 and the another device 200. These communications acknowledge the capabilities of the respective devices one to another" (Office Action, p.4). Applicants respectfully disagree.

The Office has identified base station 200 as the another device. With regard to base station 200, the Aoki reference teaches only that:

"A plurality of base stations 200 which communicates with the portable terminal 100 by wireless is connected to the junction station 210. When the portable terminal 100 is connected to the Internet 400, the junction station 210 serves on behalf of the portable terminal 100 as a terminal on the Internet 400, wherein data which is received from the portable terminal 100 via a base station 200 is transmitted to a designated terminal via the Internet 400, and wherein data on the designated terminal connected to the Internet 400 is transmitted to the portable terminal 100 via the base station 200. The portable terminal 100 simultaneously communicates with at least three base stations 200, and the junction station 210 obtains the difference in the amount of time taken for radio waves from the portable terminal 100 to reach each of the base stations 200, so that the position of the portable terminal 100 can be determined based on the time difference obtained." (para. [0061]; emphasis added)

Thus base station 200 appears merely to serve as a data conduit between portable terminal 100 and junction station 210. There is no disclosure or suggestion that any capabilities of base station 200 need be discovered by terminal 100. Absent such need, it is unreasonable to assume that any such discovery signal would be communicated from terminal 100 to base station 200. There is no disclosure or suggestion that terminal 100 need know anything about a particular

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base station 200 with which it is communicating. Instead, it is likely that terminal 100 is preconfigured with the ability to transmit or receive according to the particular wireless protocol employed by terminal 100 and base station 200.

The novel features of the present invention are not anticipated by the Aoki reference in that at least one essential element, arranged as required by the claim and recited in as complete detail as in the claim, is absent from the reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Rejection Under 35 USC §103

Claims 32-33 have been rejected under 35 USC §103 (a), as being unpatentable over U.S. patent application publication 2002/0032652 to Aoki et al. ("Aoki"). Applicants respectfully traverse the rejection and request reconsideration.

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

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The rejection of independent claim 32 is respectfully traversed for at least the following reasons. Claim 32 recites:

“32. (Original) A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at an Internet location indicated by the reference;

including the reference in a communication signal formatted according to a Bluetooth communication protocol; and

wirelessly communicating the communication signal to a print device thereby causing the print device to use the reference to retrieve the print content from the Internet and to print the print content.” (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicants’ claim limitations.

The Aoki reference does not teach or suggest the limitation of a portable wireless device wirelessly communicating the communication signal to a print device.

The portable terminal 100 wirelessly communicates a communication signal only to base station 200, which is not a print device. Base station 200 then connects, through junction station 210, to the Internet 400. Print devices, such as output terminals 21 (Fig. 1) and printing apparatuses PR (Fig. 2) are also connected to the Internet 400. All of the connections to Internet 400 (i.e. junction station 210, output terminals 21, printing apparatuses PR, WWW servers DS, output control terminal 300, data format conversion terminals CS) are wired connections. For this reason, terminal 100 cannot wirelessly communicate the communication signal which includes the reference to the print device, as required by claim 32.

Therefore, for the reasons discussed herein, the applied reference does not teach or suggest all of Applicants’ claim limitations.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no articulated reason with some rational underpinning that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. *In Re Kahn*, 441 F.3d, 977, 988 (CA Fed. 2006). The Office states that the Aoki

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references can be modified because "the use of Bluetooth is not specifically taught by applicant neither is a motivation provided as to why Bluetooth would be preferred as opposed to other methods". Applicants respectfully disagree. The specification clearly discloses the use of Bluetooth technology in the present application (p.7, line 24 – p.6, line 8). In addition, there is no requirement for the Applicants to provide in the specification any rationale as to why, or whether, one technology or embodiment is preferred versus another. Thus Applicants believe that the reason provided by the Office is too vague and thus lacks the rational underpinning required for validly combining the references. Consequently, this rationale impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Because the Office has not provided an articulated reason with some rational underpinning to combine the prior art elements in the manner claimed, it is improper to modify the Aoki reference as proposed by the Office and the rejection under 103(a) should be withdrawn.

The rejection of independent claim 33 is respectfully traversed for at least the following reasons. Claim 33 recites:

"33. (Currently amended) A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at an Internet location indicated by the reference;

including the reference in a communication signal formatted according to a Bluetooth communication protocol; and

wirelessly communicating the communication signal to a print service thereby causing the print service to use the reference to retrieve the print content from the Internet, to format the print content for printing, and to pass the print content to a print device for printing in response to the receipt of the communication signal by the print service." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicants' claim limitations.

With regard to the limitation of wirelessly communicating the communication signal to a print device thereby causing the print service to use the reference to pass the print content to a print device for printing in response to the receipt of the communication signal by the print

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service, the Aoki reference does not teach or suggest this limitation for similar reasons as explained heretofore with regard to claim 3.

Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicants' claim limitations.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no articulated reason with some rational underpinning that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. Because so such articulated reason is provided, there is no rational underpinning for validly combining the references. Consequently, this rationale impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Because the Office has not provided an articulated reason with some rational underpinning to combine the prior art elements in the manner claimed, it is improper to modify the Aoki reference as proposed by the Office and the rejection under 103(a) should be withdrawn.

Conclusion

Attorney for Applicants has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

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Respectfully submitted,



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